BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

I.

Opinions of the Courts Below.

The opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 142 F. (2d) 707, and is printed in the record, at Vol. II, pages 823 to 827. The opinion of the District Court is reported in 47 F. Supp. 322, and is printed in the record, at Vol. II, pages 768 to 775. The Circuit Court of Appeals rendered no opinion explanatory of its denial of plaintiff's petition for rehearing.

II.

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked are set forth at page 5 *ante* of the accompanying petition.

III.

Statement of the Case.

The material facts and the questions involved are set forth in the foregoing petition, to which reference is made.

IV.

Specification of Errors.

The Circuit Court of Appeals for the Seventh Circuit erred:

(1) In failing to apply the federal statutory tests of infringement of a statutory trade-mark registered under the Trade-Mark Act of 1905—the tests being set forth in Section 16 of that Act (U. S. C., Title 15, Section 96)—but, instead, in applying the tests of common or local law.

(2) In approving the conclusion of the District Court that

> "the applicable tests in this case were *the old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud."*

(3) In holding that

> "the only question left for determination is whether the plaintiff is entitled *under the common law* to exclude the defendant from the use of the word 'Pachisi.'"

(4) In applying the common law rule, as adopted in *Selchow* v. *Chaffee & Selchow Co.*, C. C. 132 Fed. 996,—a case decided prior to the enactment of the Trade-Mark Act of 1905,—and in holding that defendants

> "had the right to use the name 'Pachisi,' which was the correct name for a game in the Hindu language * * *."

(5) In holding that proof of the acquisition of a secondary meaning by the trade-mark "Parcheesi" was a

* Unless otherwise indicated, emphasis is ours.

necessary element in plaintiff's case for infringement of its statutory trade-mark instead of affording a presumption of secondary meaning as this Court, in the *Davids* case, has said follows from registration under the ten-year clause of the Act of 1905.

(6) In approving the ruling of the District Court that the trade-mark "Parcheesi" had not acquired a secondary meaning.

(7) In affirming the judgment of the District Court which involved the holding that, although plaintiff is the owner of a valid registration of the trade-mark "Parcheesi," still it does not have the right to exclude others from using the notation "Pachisi,"—obviously a "colorable imitation" of plaintiff's "Parcheesi" within the meaning of Section 16 of the 1905 Act.

(8) In affirming the holding of the District Court that plaintiff's registration of the trade-mark "Parcheesi" is valid, and that the mark has not been abandoned, and yet in failing to afford the plaintiff any protection as owner of that trade-mark.

(9) In failing to hold that plaintiff's statutory trade-mark "Parcheesi" is not "descriptive of the goods, with which they are used, or of the character or quality of such goods,"—within the meaning of Section 5 of the Trade-Mark Act of 1905 (U. S. C. Title 15, Section 85)—as applied to plaintiff's and also to the defendant's board and counter game sets.

(10) In affirming the ruling of the District Court vacating the temporary injunction theretofore granted.

(11) In affirming dismissal of plaintiff's supplemental complaint and thereby authorizing defendants to market their proposed red game.

V.

Argument.

It is believed that the questions presented and the reasons for allowance of the writ of certiorari, as set forth in the foregoing petition (pp. 6-10) sufficiently summarize the argument.

Proposition 1. The categories of trade-marks that may be registered under the Act of 1905, the rights of the owner of a trade-mark so registered, the tests of liability for their violation, the forms of action for infringement thereof, the defenses available and the remedies for infringement are all encompassed within the provisions of that Act. Consequently, all questions involved in an action for infringement of a trade-mark so registered are federal questions, and their decision is governed by federal law and not by local law relating to common law trade-marks or unfair competition.

It has been pointed out, in the "Summary Statement of the Matter Involved," that plaintiff brought its action for infringement of its trade-mark "Parcheesi," registered under the Act of 1905; and that plaintiff included counts for infringement of its common law rights in the same trade-mark, and for unfair competition.

Although the District Court entered judgment for the defendants, it held plaintiff's registration to be valid and that plaintiff is the owner of the trade-mark "Parcheesi" and of "the business and good will connected therewith" (Conclusions of Law Nos. 2 and 3, R. Vol. II, p. 786); and that the trade-mark has not been abandoned (Finding of Fact No. 13, R. Vol. II, p. 781). The defendants took no cross-appeal; consequently they are concluded by the rulings adverse to them,—namely, that plaintiff is the owner

of a valid registered trade-mark which has not been abandoned; and of the business and good will connected therewith.

LeTulle v. *Scofield*, 308 U. S. 415, 421, 422;
Morley Construction Co. v. *Maryland Casualty Co.*, 300 U. S. 185, 191;
Alexander v. *Cosden Pipe Line Co.*, 290 U. S. 484, 487.

Thus, conclusively adjudged to be the owner of a valid registration of its trade-mark "Parcheesi," petitioner feels that it need no longer rely upon asserted infringement of its common law rights and unfair competition by the respondents. Therefore, in seeking review by this Court of the adverse judgment of the court below, petitioner proposes to rely solely upon the rights, tests of infringement and remedies available to it under the Act of 1905.

The presently pertinent provisions of the Trade-Mark Act of 1905 (U. S. C., Title 15, Sections 81-109) are reproduced in Appendix A to this petition and brief.

The Act provides a completely adequate basis for the decision of every question that can arise in an action for the infringement of a trade-mark registered thereunder. Every such question is a federal question; and the answer thereto is to be derived from that federal Act and to be governed by federal law.

Pecheur Lozenge Co. v. *National Candy Co.* has been cited above under plaintiff's fifth reason for allowance of the writ of certiorari. There this Court had intended to, but, because the facts would not permit, did not, decide the question whether local law or federal law should be applied in a suit for infringement of a trade-mark regis-

tered under the Act of 1905. However, the later decision of this Court in *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U. S. 173,—wherein this Court reaffirmed broadly a doctrine that it had announced in earlier decisions,—indicates clearly that where legal relations lie within the compass of a valid federal statute (such as the Trademark Act of 1905) questions touching those legal relations are federal questions and are to be answered by applying the provisions of the statute and federal law, and not by applying local law in conflict therewith.

In the *Sola* case this Court said, at page 176 of 317 U. S.:

> "It is familiar doctrine that the prohibition of a federal statute may not be set at naught, or its benefits denied, by state statutes or common law rules. In such a case our decision is not controlled by *Erie R. Co.* v. *Tompkins*, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817, 114 A. L. R. 1487. There we followed state law because it was the law to be applied in the federal courts. But the doctrine of that case is inapplicable to those areas of judicial decision within which the policy of the law is so dominated by the sweep of federal statutes that legal relations which they affect must be deemed governed by federal law having its source in those statutes, rather than by local law." (Citing cases.) "When a federal statute condemns an act as unlawful, the extent and nature of the legal consequences of the condemnation, though left by the statute to judicial determination, are nevertheless federal questions, the answers to which are to be derived from the statute and the federal policy which it has adopted. To the federal statute and policy, conflicting state law and policy must yield." (Citing authorities.)

The *Sola* case did not involve trade-mark matters. Nevertheless, in deciding the case of *Philco Corp.* v. *Phillips Mfg. Co.*, 133 F. (2d) 663,—which, like the case at bar,

involved counts for infringement of a trade-mark registered under the Act of 1905, for common law trade-mark infringement and for unfair competition—the court below unquestionably applied the doctrine of the *Sola* case; for it said, at pages 671 and 672 of 133 F. (2d):

> "* * * The policy of a statute which Congress has enacted under its constitutional power to regulate interstate commerce may not be defeated or obstructed by State law, whether decisional," (citing cases) "or statutory," (citing cases). "Through the Trade-Mark Acts of 1905 and 1920 Congress has occupied that part of the field of unfair competition in interstate commerce having to do with 'passing off' effected solely by the use of a trade-mark. The intention of Congress was to achieve uniformity within the area occupied. In so far as State law conflicts with this policy of the Trade-Mark Acts, it must yield to the superior federal law. Clause 2, Article VI, Constitution of the United States. * * *"

In a footnote at this point the Court of Appeals said that

> "The reason this question was not raised prior to the Erie case was that under the 'federal rule' the federal courts provided uniform protection for trade-marks which was more extensive than the protection usually allowed by State courts."

Thereafter the Court of Appeals said:

> "It goes without saying that plaintiff has no action for common law trade-mark infringement under State law. Registration of plaintiff's trade-mark rendered all questions concerning its use and protection in interstate commerce questions of federal law, and federal law is supreme."

Again, in *Dwinell-Wright Co.* v. *National Fruit Product Co.*, 140 F. (2d) 618, at page 620, the Circuit Court of Appeals for the First Circuit said that

> "* * * The court below concluded that on the question of infringement of registered trade-marks the applicable law is federal statutory law, and where that is ambiguous or silent, federal case law, and we agree."

In the case at bar, however, the court below said, at page 709 of 142 F. (2d) (R. Vol. II, p. 826):

> "* * * The District Court therefore concluded that *the applicable tests in this case were the old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud. See *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corp.*, 305 U. S. 315, 59 S. Ct. 191, 83 L. Ed. 195. The ruling of the District Court in this respect, we think, was proper, and the only question left for determination is whether the plaintiff is entitled *under the common law* to exclude the defendant from the use of the word 'Pachisi.'"

Incidentally, the *Nu-Enamel* case, cited by the court below, can have no application to the present suit, because that case involved a trade-mark registration under the Act of 1920, which affords a registrant thereunder only the right to sue in the federal courts irrespective of diversity of citizenship but accords him none of the presumptions afforded by registration under the Act of 1905.

Petitioner submits that the matter last above quoted from the opinion of the court below affords, without more, ample reason for the issuance of a writ of certiorari. Not only has the court below thereby decided important questions of federal law which have not been, but should be, settled by this Court, but also its application of local law instead of federal law in reaching its decision conflicts with the decision of the Circuit Court of Appeals for the First Circuit in the *Dwinell-Wright* case (140 F. (2d) 618,

620), *supra*, as well as with its own decision in the *Philco* case (133 F. (2d) 663, 671, 672), *supra*.

Proposition 2. After validating the federal registration of petitioner's trade-mark "Parcheesi" the court below should have applied the statutory tests of infringement in determining respondents' liability for their use of the word "Pachisi."

In the main this proposition is but a special case coming under Proposition 1, just discussed. There are, however, additional aspects of the present proposition which seem to merit separate consideration.

The court below said, at page 709 of 142 F. (2d) (R. Vol. II, p. 826):

> "* * * There is no substantial evidence in this case to prove that there was any fraud or palming off with respect to the defendant's product unless it can be said that the word 'Parcheesi' has acquired a secondary meaning, that is to say that in the minds of the purchasing public, it means the producer rather than the product. See *Kellogg Co.* v. *National Biscuit Co.*, 305 U. S. 111, 59 S. Ct. 109, 83 L. Ed. 73; *Steem-Electric Corp.* v. *Herzfeld-Phillipson Co.*, 7 Cir., 118 F. 2d 122. The District Court was of the opinion that that word had not acquired a secondary meaning. That court very properly said: 'Not one purchaser in a thousand would know or care whether Selchow and Righter Company was the manufacturer. The fact is that the public in general knows "Parcheesi" as a game and not as an article made by the plaintiff.' 47 F. Supp. 322, 326. * * *"

Neither the *Kellogg* case nor the *Steem-Electric* case, thus cited by the court below, is applicable to the instant case. The trade-marks involved in the *Kellogg* case were registered under the Act of 1920. In the *Steem-Electric*

case, there was one trade-mark registration under the Act of 1920, and another registration under the Act of 1905,—the latter involving a design including the words "Steem-Electric," which words were disclaimed apart from the mark; and infringement was predicated upon the use of only the words "Steam-O-Matic."

Not only did the court below fail to apply the statutory tests of infringement provided in Section 16 of the Act of 1905 (U. S. C., Title 15, Section 96), but also, as a condition precedent to the granting of any relief, it impliedly required an affirmative showing by the plaintiff that its registered trade-mark "Parcheesi" had acquired a secondary meaning. By such requirement, however, the court below brought itself into direct conflict with the decision of this Court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S. 461.

In the *Davids* case this Court construed the Trade-Mark Act of 1905 with particular reference to the rights and remedies available to the owner of a trade-mark,—consisting of the surname "DAVIDS," as applied to inks—which had been registered under the ten-year clause of that Act.

The following extracts from the opinion of this Court in the *Davids* case, together with petitioner's interpolated comments, should suffice to demonstrate how conclusively that case should have constrained the court below to reach a conclusion just the opposite of the one it did reach.

In the *Davids* case at page 469 of 233 U. S., this Court, with reference to the ten-year clause, said:

> "* * * The applicant who, by virtue of actual and exclusive use, is entitled to register his mark under this clause, becomes on due registration the 'owner' of a 'trademark' within the meaning of the act, and he *is entitled to be protected* in its use as such."

In affirming the ruling of the District Court that plaintiff is the owner of a valid registration of its trade-mark "Parcheesi," and yet in affirming at the same time dismissal of the complaint and of the supplemental complaint in the face of the clearest infringement by defendants' use of an *idem sonans*, "Pachisi," the court below disregarded one of the most ancient maxims of the law,—namely, that where there is a right, there is a remedy.

Again in the *Davids* case, at pages 469-470, of 233 U. S. —after quoting tests of infringement under § 16,—U. S. C., Title 15, Section 96, this Court said:

> "* * * This provision applies to all trademarks that are within the act, including those which come under the ten-year clause, provided they are not used 'in unlawful business,' or 'upon any article injurious in itself,' or 'with the design of deceiving the public,' and have not been 'abandoned' (§21)," (U. S. C., Title 15, Section 101.)
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> "But, while this is true, the inquiry as to the extent of the right thus secured by the statute, in the case of marks which are admitted to registration under the ten-year clause, is not completely answered. * * * Congress has admitted to registration the names or terms belonging to the class under consideration simply because of their prior use as trademarks, although they had not been such in law. Their exclusive use as trademarks for the stated period *was deemed, in the judgment of Congress, a sufficient assurance that they had acquired a secondary meaning* as the designation of the origin or ownership of the merchandise to which they were affixed. * * *"

There can be no shadow of a doubt that the sentence last above quoted means that the valid registration of a trade-mark under the ten-year clause carries with it the presumption that the trade-mark has acquired a second-

ary meaning. Indeed, in *Coca-Cola Co.* v. *Nashville Syrup Co.*, 200 Fed. 153, 155 (affirmed, C. C. A. 6th, 215 Fed. 527), Judge,—later Mr. Justice—Sanford said that Section 5 of the Act of 1905

> "* * * in effect merely gives a conclusive presumption of secondary meaning to a trade-mark in actual and exclusive use for a period of ten years. * * *"

Consequently, in affirming the ruling of the District Court that plaintiff is the owner of a valid registration of its trade-mark "Parcheesi," and yet in approving, at the same time, the ruling of the District Court that "Parcheesi" had not acquired a secondary meaning, the court below rendered a decision clearly in conflict with the decision of this Court in the *Davids* case.

And still further in the *Davids* case at page 471 of 233 U. S.—after pointing out that the reproduction, copy, or imitation, which constituted infringement of a mark registered under the ten-year clause, must be such as is calculated to mislead the public with respect to the origin or ownership of the goods, this Court said:

> "* * * This is not to say that, in this view, the case becomes one simply of unfair competition, as that category has been defined in the law; for, whatever analogy may exist with respect to the scope of protection in this class of cases, *still the right to be protected against an unwarranted use of the registered mark has been made a statutory right,* * * *."

On the other hand, in this case the court below agreed with the District Court that

> "* * * the applicable tests in this case were the *old common law rules of unfair competition* with the exception of the requirement of proof of an attempt to defraud. * * *" (142 F. (2d), at page 709 (R. Vol. II, p. 826).)

Thus, the court below rendered a decision directly in conflict with the ruling of this Court in the *Davids* case,—namely, that a case for infringement of a trade-mark registered under the ten-year clause does not become one simply of unfair competition at common law.

In the *Davids* case this Court agreed with the trial court that the defendants there had infringed the registered mark "DAVIDS" by putting "C. I. DAVIDS" at the top of their labels, and at the bottom thereof "DAVIDS MFG. CO." This Court then added, at page 472 of 233 U. S.:

> "* * * The use of the name in this manner was a mere simulation of the complainant's mark which it had duly registered; it constituted a 'colorable imitation' within the meaning of the act. * * *"

In completely analogous fashion, the use of the mark "Pachisi" by the present defendants clearly would be "a mere simulation of the complainant's mark which it had duly registered"; and would just as clearly constitute a "colorable imitation" of plaintiff's trade-mark "Parcheesi" "within the meaning of the act."

That this Court has not varied from the doctrine announced in the *Davids* case,—namely, that "the right to be protected against an unwarranted use of the registered mark has been made a statutory right," is emphasized by the fact that in *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U. S. 203, 205, this Court cited the *Davids* case and quoted therefrom the words last quoted above.

Petitioner submits that this Court should allow a review of the decision of the court below if only to avert the crystallization into precedent of the ruling of the Circuit Court of Appeals for the Seventh Circuit that there can be valid registration of a trade-mark under the Act

of 1905 without the registrant being afforded the protection prescribed by that Act.

Proposition 3. Petitioner's trade-mark "Parcheesi" is not "descriptive of the goods" with which it is used, "or of the character or quality of such goods," within the meaning of Section 5 of the Trade-Mark Act of 1905.

The factual basis, apparently held by the District Court as sufficient to support its holding that "Pachisi" (as well as "Parcheesi") is descriptive of plaintiff's game sets, appears in the following excerpts from the opinion of that court, at pages 324, 325, and 326 of 47 Fed. Supp.; R. Vol. II, pp. 770, 772, and 773):

> "For many years prior to 1869 a game similar to plaintiff's 'Parcheesi' was played in India. The highest count that could be made in the Indian game was twenty-five, and the Hindustani or Hindi word for 'twenty-five' sounded very similar to 'Patcheesi,' 'Parcheesi,' or 'Pachisi.' In fact, the game in India has come to be known as 'Pachisi' and is often referred to as the national game of India.
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> * * * * * *
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> "Plaintiff contends that the game which it manufactures is not the Hindi game of 'Pachisi' because the rules differ in certain respects. The Hindi game in evidence showed plaintiff's board is greatly similar. In each game the boards are cruciform, having a center square and four arms. In each instance the arms are divided into three pathways, and the number of divisions or sections in each pathway is practically the same. Each game is played by two to four persons, with playing pieces to be moved upon the board. The Hindi game uses cowries to determine the number of spaces which the pieces may be moved, while in plaintiff's modern version, dice are used. The primary object in each game is to get the players 'Home.' But such slight variations in the rules are not of importance. * * *

> "The testimony in the case at bar establishes that the correct spelling of the Indian name is 'Pachisi.' While it is true that this is the Indian word for 'twenty-five,' it is also the name of the Indian game which is similar to plaintiff's game of 'Parcheesi' as well as to the defendant's proposed game."

The first two of the excerpts just quoted repeat, in substance, Findings of Fact Nos. 31 and 32 (R. Vol. II, p. 785).

The substance of the above quoted observations of the District Court appears in the testimony, on direct and cross-examination, of the plaintiffs' expert, Dr. William Norman Brown, Professor of Sanskrit at the University of Pennsylvania (R. Vol. I, pp. 27-59; 145-146). Extracts from Dr. Brown's testimony, which will serve to clarify, as well as to amplify, the references of the District Court to the Indian game "similar to plaintiff's 'Parcheesi,' " to the highest count as twenty-five (pachisi) and to the use of cowries in the Hindi game, are reproduced in Appendix B to this brief.

The following are the salient, and presently pertinent, facts to be gleaned from the uncontradicted testimony of Dr. Brown presented in Appendix B:

(a) The Hindi word "pachisi" is not primarily the name of a game in India, but means "of twenty-five," and is applied to any collection of twenty-five things.

(b) The playing cloth or board in India is called "chausar" or "chaupar," and derives its name from the four arms making up its cruciform design.

(c) A game played in India on the "chausar" or "chaupar" board, using stick dice, is called "chausar" or "chaupar" (four-limbed) from the name of the playing

board; and the stick dice, usually three in number, are marked on their four long sides with spots or characters that render it impossible to make a throw "pachisi," that is, "of twenty-five."

(d) It is only when cowrie shells, without spots, are used, instead of stick dice,—so that a throw of twenty-five (usually the highest count) can be made,—that the game is known in India as "pachisi."

(e) Dr. Brown, as a boy, took to India one of plaintiff's game sets, but he was unsuccessful in playing the game with Hindi children because he used cube dice and they wanted to play with cowries. He, in turn, found it difficult to play the Indian game of "pachisi" because of the complicated system of counting attached to throws of the cowries.

To fill out, then, the factual background that was omitted by the District Court: There is no game played in India under the appellation "pachisi" wherein the moves are determined other than by throws of a number of unmarked cowrie shells. With the same playing board, if stick dice are used, the name of the game,—*i.e.*, "chaupar" or "chausar," the former being taken from the Hindi name of the board,—does not remotely resemble "pachisi." Consequently, if the defendants want to use the name "pachisi," they should be restricted to the game by that name; in other words, they should be limited to the marketing of a game set comprising a playing board substantially identical with a chaupar board or cloth, counters, and unmarked cowries.

But there is one piece of evidence, provided by the defendants themselves, which demonstrates that in a vital respect,—namely, in the location of safety points thereon, —a chaupar board does not correspond to the playing

boards of the plaintiff (and of the defendants); and, as a consequence, that a throw of twenty-five (pachisi) with cowrie shells cannot achieve the same objective on one of plaintiff's boards,—*i.e.*, jumping a counter from one safety point to another,—that is possible on a chaupar cloth. This evidence appears in Defendants' Exhibit 9, comprising Chapter XXVII, pages 257 to 262, inclusive, of "Games Ancient and Oriental and How to Play Them," by Edward Falkener (London—1892). This exhibit was received in evidence at Vol. I, page 154, of the record; and is reproduced at Vol. II, pages 714 to 727 thereof.

The presently important details of Falkener's description are (a) that certain ornamented spaces on a chaupar cloth, or board, termed "castles," serve as safety points on which pieces are free from capture; and (b) that these castles are placed on the board so that, in a number of instances, two castles are 25 spaces apart,—Falkener pointing out, "hence the name of the game." The count of 25 spaces between certain pairs of castles, specifically pointed out by Falkener (R. Vol. II, pp. 725, 726), may be verified by reference either to Falkener's photograph of a chaupar cloth (showing also stick dice and cowries) at Vol. II, page 715 of the record, or to the engraving of the cruciform playing surface at page 723.

If the relative positions of the castles on either of these Falkener illustrations of a chaupar board be compared with the relative positions of the "Safety Points" *a*, *a*, *a* on one of plaintiff's boards,—as exemplified in the diagram (R. Vol. II, p. 505) making up part of Plaintiff's Exhibit EA, consisting of instruction folders "How to Play Parcheesi," received in evidence at Vol. I, page 109 of the record,—it will be seen that the laterally positioned castles on each arm of a chaupar cloth are *four* spaces

from the end of the arm, whereas the corresponding "Safety Points" on plaintiff's board (so also on defendants' board) are *five* spaces from the end of the arm.

This apparently insignificant shift of the lateral safety points on plaintiff's (and also defendants') board from the positions occupied by corresponding castles on a chaupar board in reality is vitally material to the issue whether "pachisi" (twenty-five), or its *idem sonans*, "Parcheesi," is descriptive of plaintiff's game sets; for, in contrast with a chaupar board, there are no two "Safety Points" on plaintiff's or defendants' board that are 25 spaces apart. Hence, even though cowries were to be used in playing a game on one of plaintiff's or defendants' boards, the highest count therewith, namely, twenty-five or "pachisi," could not achieve the same objective as it might on a chaupar board,—that is, the jumping of a piece or counter from one safety point to another.

Indeed, it is highly probable that the specific positioning of the safety points on plaintiff's boards,—going back at least to the year 1871 (Plaintiff's Exhibit GD, received in evidence R. Vol. I, page 112, and reproduced at R. Vol. II, page 521),—was done advisedly and with a view to the use of ordinary cube dice; thus affording a player the possibility of being able to jump a piece from one safety point to another by making throws of 5, 7, 10, or 12 with such dice.

It results that "Parcheesi" is not descriptive as applied to plaintiff's game sets or to any characteristic of the game played therewith; and that the court below erred in so holding.

The facts involved in the case of *LeBlume Import Co.* v. *Coty*, 293 Fed. 344 (2 Cir.), furnish a close parallel to the facts summarized under the present Proposition 3 to show

that plaintiff's game set in no sense is a reproduction of the Indian game of pachisi. But the ruling of the court below is in direct conflict with that of the Circuit Court of Appeals for the Second Circuit in *LeBlume* v. *Coty*.

The case just cited involved the question whether the trade-mark "Lorigan," which had been registered under Section 5 of the Trade-Mark Act of 1905, as applied to a perfume blend or bouquet, was infringed by the use of the word "Origan" when applied to a similar blended perfume. The principal defense was invalidity of the registration of "Lorigan" on the ground of descriptiveness,—particularly in view of the fact that the trade-mark owner used the word "L'Origan" instead of the registered form "Lorigan."

The Circuit Court of Appeals for the Second Circuit said, at pages 353 and 357 of 293 Fed.:

> "* * * The word 'origan' is an English word, and one of great antiquity. The New Standard Dictionary defines it as 'wild marjoram' and states that it is 'rare.' And the Century Dictionary defines it as 'a plant of the genus Origanum; marjoram; wild marjoram; also pennyroyal.' And 'origanum' is defined in the same work as 'a genus of labiate plants of the tribe Satureineae and the subtribe Menthoideae.' It is added, 'There are about 30 species, mainly of the Mediterranean region.' While the word 'origan' has retained its currency among pharmacists and botanists, its use for many years seems to have been almost exclusively confined to them, and it has been only occasionally used in modern English literature. It is in no sense a word of common speech in English.
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> * * * * * *
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> "There is abundant testimony in the record to the effect that 'L'Origan' is a blend or bouquet, and that its odor is not that of any particular flower. * * *"

In holding the registration of "Lorigan" to be valid, and in affirming injunctional orders involved in the appeal the Second Circuit Court of Appeals,—having reference to the meaning of the word "descriptive," as used in Section 5 of the Trade-Mark Act of 1905,—said, at pages 351 and 358 to 359 of 293 Fed.:

> "* * * The cases show that the courts under certain circumstances protect the use of words as trade-marks, even though they suggest the ingredients, qualities or characteristics of the goods. The distinction is between words which are 'descriptive' and those which are merely 'suggestive.' * * *
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> * * * * * *
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> "* * * we think that a word which is not in general or common use, and is unintelligible and non-descriptive to the general public, although it may be known to linguists and scientists, may be regarded as arbitrary and fanciful, and capable of being used as a trade-mark or a trade-name; * * *."

Petitioner submits that, under a state of facts which parallels closely that in *LeBlume* v. *Coty,* its trade-mark "Parcheesi" is at the most only suggestive of its game sets; and that it is not descriptive of petitioner's goods, within the meaning of the Trade-Mark Act of 1905, where the trade-mark, at the time of its initial use in this country, prior to 1870, by petitioner's predecessor in title, was unintelligible and non-descriptive to the general public.

VI.

Conclusion.

On the foregoing argument, plaintiff-petitioner submits that the Circuit Court of Appeals was in error in the several respects covered by the petition and brief; that its errors are in matters of general importance to the public in relation to the scope and application of federal trademark law; that it has departed from doctrines announced by this Court; and that its judgment is entirely erroneous.

Wherefore, your petitioner prays that its petition be granted; that the writ of certiorari be issued and the cause reviewed; and that the judgment of the Circuit Court of Appeals for the Seventh Circuit be reversed.

Respectfully submitted,

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